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09/699,554	10/31/2000	Katsumi Nihei	Q61559	7384

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Sughrue Mion Zinn Macpeak & SEas
2100 Pennsylvania Ave N W
Washington, DC 20037-3202

EXAMINER

USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/699,554	Applicant(s) NIHEI, KATSUMI	
	Examiner Joseph G. Ustaris	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated January 19, 2007 in application 09/699,554.

Claim Objections

2. Claim 9 is objected to because the limitation "said mobile advertisement receiver" lacks antecedence. The examiner shall presume that "said mobile advertisement receiver" simply refers to "a mobile advertisement receiver". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The USPTO "Interim Guidelines for Examination of Patent Applications for Patent

Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that

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increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 12 defines a program providing medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed program providing medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent that is executed by the computer in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Alexander et al. (US006177931B1) and Bandera et al (US006332127B1).

Regarding claim 1, Zigmond et al. (Zigmond) discloses a system and method for selecting and inserting advertisements or "an advertisement method for presenting advertisement data, transmitted by broadcasting, to users" (See Figs. 3-5). At the household or "user site" is a WebTV box or "receiver" that is able to set "selections standards" for the user. The WebTV box includes an ad insertion device where it stores viewer and system information that is used to select advertisements (See Fig. 5, element 82). The viewer and system information defines "selection standard" such as "receive time, a receive position of the user site, and preference of the user" (See column 10 lines 47-63). The system then uses the "selection standards" to filter or "select" advertisements that meet the "selections standards" and proceeds to store the filtered advertisements in an advertisement repository or "advertisement database" (See Fig 5, elements 82, 83, 84, and 86; column 15 lines 17-23). However, Zigmond does not explicitly disclose (1) assigning an evaluation value to the stored advertisement data based on a reproduction time, a reproduction position and preference of the user, extracting the advertisement data in the order of highest evaluation value, and presenting the extracted advertisement data to the user in the order of highest evaluation value and (2) that the user is mobile.

Alexander et al. (Alexander) discloses a system for providing advertisements to the user. Alexander discloses that stored advertisements (See column 20 line 66 – column 21 line 5)

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are assigned a priority value or "evaluation value" (See column 26 lines 45-56) based on a "reproduction time, a reproduction position of the user site, and preference of the user" (column 26 line 61 – column 27 line 7 and column 28 lines 10-21). The stored advertisements are extracted in the order of highest priority value or "evaluation value" and presented to the user in the order of the highest priority value or "evaluation value" (See column 26 lines 45-56). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement system disclosed by Zigmond to assign a priority value to the stored advertisement data based on a reproduction time, a reproduction position of the mobile user site, and preference of the user, extracting the advertisement data in the order of highest priority value, and presenting the extracted advertisement data to the user in the order of highest priority value, as taught by Alexander, in order to improve the opportunities for the commercial advertisers to reach the targeted users/viewers.

Bandera et al. (Bandera) discloses a system for providing advertisements to the user. Bandera discloses a mobile user using a mobile web client that is able to receive advertisements (See Fig. 2). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement system disclosed by Zigmond to allow the user to be mobile by using a mobile web client, as taught by Bandera, in order to enhance the efficacy of advertising to users accessing the Web via mobile devices (See col. 2 lines 11-27).

Regarding claim 2, the advertisements have data "representing a period of an advertisement", wherein the advertisement is only selected, stored, and displayed if it meets the "selection standards" (See Zigmond column 13 lines 59-67).

Regarding claim 3, the advertisements have data "representing the position of the location of the advertisement target", wherein the advertisement is only selected, stored, and displayed if it meets the "selection standards" (See Zigmond column 14 lines 49-58).

Claim 9 contains the limitations of claim 1 (wherein the WebTV performs the functions of the "advertisement receiving section" (See Zigmond Fig. 5, AD Delivery), "received advertisement database" (See Zigmond Fig. 5, Advertisement Repository), "time, position, and preference obtaining sections" as well as the "advertisement storage processing section" (See Zigmond Fig. 5, viewer and system information; column 10 lines 47-63), "advertisement extracting section" (See Zigmond Fig. 5), and the "advertisement presentation section" (See Zigmond Fig. 5, display)) and is analyzed as previously discussed with respect to those claims. The WebTV box is also considered a "mobile advertisement receiver" wherein the WebTV box is capable of being moved from one location to another (See Zigmond col. 6 lines 30-47 and col. 7 lines 37-49) or the mobile web client (See Bandera Fig. 2). Furthermore, the advertisements are transmitted by content providers or various other AD sources or "advertisement transmitters" (See Zigmond Figs. 3 and 7). The content providers and AD source have "transmission advertisement databases" (See Zigmond Fig. 3 and 7, AD) and inherently have "mobile advertisement obtaining sections" and "advertisement transmitting section" in order to successfully deliver the "advertisement transmission row" (See Zigmond Figs. 2, 3, and 7) to the WebTV box or receiver.

Claim 11 contains the limitations of claims 1 and 9 (wherein the WebTV is the "mobile advertisement receiver" or the mobile web client (See Bandera Fig. 2)) and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, Zigmond discloses that the advertisement system discussed in claim 1 may also be embodied as a computer program product on a computer-usable storage medium (See Zigmond column 6 lines 48-67).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Alexander et al. (US006177931 B1) and Bandera et al (US006332127B1) as applied to claims 1-3, 9, 11, and 12 above, and further in view of Hendricks et al. (US006408437B1).

Zigmond in view of Alexander and Bandera does not disclose a method where the "selection standards" can store key words that are and are not of interest to the user.

Hendricks et al. (Hendricks) discloses a set top terminal that receives programs or "advertisements" and is able to search through programs that contain key words, which are and are not of interest to the user. The key words can be stored within a downloaded thesaurus. Any programs that contain key words that are not of interest to the user are excluded (See column 31 lines 5-10 and column 32 lines 42-51). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the viewer and system information and AD selection criteria disclosed by Zigmond in view of Alexander and Bandera to be able to store key words that are and are not of interest

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to the user, as taught by Hendricks, in order to provide a more accurate filtering process when searching through programs or "advertisements".

8. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Alexander et al. (US006177931 B1) and Bandera et al (US006332127B1) as applied to claims 1-3, 9, 11, and 12 above, and further in view of Rakavy et al. (US006317789B1).

Zigmond in view of Alexander and Bandera does not disclose a method where the advertisements that are expired and that have been displayed a certain number of times are deleted from the local cache of the mobile web client.

Rakavy et al. discloses an Advertisement Killer or "advertisement deletion processing" that purges advertisements that have been stored for a certain time or "present time outside said period" and advertisements that have been displayed a number of times or "presented a number of times equal to said number" (See column 12 lines 60-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement system disclosed by Zigmond in view of Alexander and Bandera to include an Advertisement Killer, as taught by Rakavy, in order to efficiently use the repository or "advertisement database" by freeing up more available space for newer advertisements.

9. Claims 8 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Alexander et al. (US006177931 B1) and Bandera et al (US006332127B1) as applied to claims 1-3, 9, 11, and 12 above, and further in view of Seth-Smith et al. (4,866,770).

Regarding claim 8, Zigmond in view of Alexander and Bandera discloses a "plurality of advertisement sections" (See Fig. 2A, group of ADS 20). However, Zigmond does not disclose that each "advertisement section" is repeated thus causing the same "sponsor advertisements" to be repeated in transmission.

Seth-Smith et al. (Seth-Smith) discloses a system and method for communicating video, audio, and data to various clients. Seth-Smith discloses that each data packet is repeated 5 times in a row during transmission or each "advertisement section" is repeated (See Fig. 8; column 15 lines 1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the "advertisement sections" disclosed by Zigmond in view of Alexander and Bandera to be repeated, as taught by Seth-Smith, in order to ensure that the data or "advertisements" are successfully received at the user's end of the system.

Claim 13 contains the limitations of claims 8 and 9 and is analyzed as previously discussed with respect to those claims.

Allowable Subject Matter

10. Claims 5-7 and 14 are allowed.

Response to Arguments

11. Applicant's arguments with respect to claims 1-4 and 8-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5 PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

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JGU

April 17, 2007


SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER